



Paper No. 6

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## OFFICE OF PETITIONS

In re Application of  
J. Aaron Bly, David T. Spieldanner,  
Aaron Roth, Patrick O'Brien,  
Andrew F. Suhy, Jr., and  
Brent Parent  
Application No. 09/990,911  
Filed: November 14, 2001  
Title: SYSTEM AND METHOD FOR  
DISPOSING OF ASSETS

DECISION REFUSING STATUS  
UNDER 37 C.F.R. §1.47(a)

This is a decision on the "Petition Pursuant to 37 CFR §1.47(a) involving the Refusal of a Co-inventor to Execute the Power of Attorney," filed February 19, 2002. This is properly treated as a request to accept a declaration for patent executed by less than all of the inventors pursuant to 37 CFR 1.47(a).

The petition under 37 CFR §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on November 14, 2001, without an executed declaration, and naming J. Aaron Bly, David T. Spieldanner, Aaron Roth, Patrick O'Brien, Andrew F. Suhy, Jr., and Brent Parent as joint inventors. In response to a "Notice to File Missing Parts of Application," mailed December 6, 2001, applicant timely filed the instant petition under §1.47(a) (and fee) and late surcharge under §1.16(e). Accompanying the petition were separate declarations executed in combination by inventors Bly, Spieldanner, Roth, and O'Brien on behalf of themselves and on behalf of non-signing inventors Suhy and Parent. Rule 47 applicants assert that status under §1.47(a) is proper because inventors Suhy and Parent refuse to execute the declaration. In support thereof, applicants submit a statement of facts of patent attorney Michael B. Stewart.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in

compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition includes authorization to charge the petition fee<sup>1</sup> and a statement of the last known addresses of non-signing inventors Suhy and Parent. By statement of attorney Stewart with supporting documentary evidence, rule 47 applicants have provided some evidence that non-signing inventors Suhy and Parent have refused to join in the application after having been presented with the application papers. However, the petition is not grantable because further information is required in reference to requirement (1) and the declaration submitted does not satisfy requirement (2).

As to requirement (1), a copy of the letter transmitting the application as filed and the declaration to inventor Suhy was included on petition. A showing of refusal by inventor Suhy is supported by this letter considered in light of attorney Stewart's statement of facts. However, the description of the refusals as set forth in attorney Stewart's statement is not sufficiently detailed. In detailing the circumstances of the refusal, attorney Stewart omitted specifics, such as dates and times of the telephone conversations. This information is required in order to conclude that the showing of refusal as to inventor Suhy has been made.

As for inventor Parent's refusal, for the same reasons, attorney Stewart's statement is not sufficiently detailed. Moreover, the copy of the letter transmitting the application as filed and the declaration to inventor Parent is referred to on petition, but is not present in the application. Submission of this letter with further information on the refusal is required.

As to requirement (2), the declaration is not acceptable. Pursuant to 35 USC 115 and 37 CFR 1.63(a)(3), a declaration must include the citizenship of all inventors, regardless of signing status. The declaration submitted does not include the citizenship of inventors O'Brien, Suhy and Parent. Additionally, the declaration is rendered unacceptable due to non-dated/non-initialized changes to inventor Roth's residence information. Furthermore, §1.63(c) provides that:

Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

(1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor.

A review of the declaration reveals that it contains the residence, but not the mailing address of each of the inventors. No application data sheets have been submitted in this

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<sup>1</sup> Both a surcharge under §1.16(e) for late filing of the declaration and a petition fee for acceptance of the declaration under §1.47 are required.

application. For purposes of compliance with §1.63, the data entered as the residence is being construed as both the address where the inventor lives and the address where the inventor customarily receives mail, the mailing address. Applicant must notify the Office of Petitions on request for reconsideration if this interpretation is incorrect.

On renewed petition, applicant must correct the deficiencies:

1. Provide further details on the circumstances of the refusal, consistent with the guidance set forth in MPEP 409.03(d) (8th Ed., Rev. Aug. 1, 2001); and
2. Provide a supplemental oath or declaration correcting the deficiencies noted in the declaration of record. See 37 CFR §1.67.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Commissioner for Patents  
                                 Box DAC  
                                 Washington, D.C. 20231

By FAX:                   (703) 308-6916  
                                 Attn: Office of Petitions  
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By hand:                   Office of Petitions  
                                 2201 South Clark Place  
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Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

  
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